

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Cerveceria Modelo, S.A. de C.V.,)
)
Opposer,)
)
vs.)
)
Banfi Products Corporation)
)
Applicant.)
)

Opposition No. 91157504

Serial No. 78/172,568

NOTICE OF WITHDRAWAL

Cerveceria Modelo, S.A. de C.V., by its counsel, hereby withdraws its opposition to United States Trademark Application Serial No. 78/172,568, with prejudice. A copy of the Trademark Agreement entered into by Opposer and Applicant is attached hereto.

Dated: December 23, 2003

By: _____

Michael P. Martin, Esq.

Yanny & Smith

1925 Century Park East, Suite 1260

Los Angeles, CA 90067

Telephone: (310)551-2966

Attorneys for the Opposer

Cerveceria Modelo, S.A. de C.V.



12-29-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #76

A

TRADEMARK AGREEMENT

PARTIES

1. **THIS AGREEMENT**, effective as of the last date below written, is by and between CERVECERIA MODELO, S.A. de C.V., a corporation organized and existing under the laws of Mexico and having its principal offices at Lago Alberto No. 156, Colonia Anahuac C.P. 11320, Mexico, D.F., Mexico, ("Modelo") and Banfi Products Corporation, a corporation organized and existing under the laws of New York and having its principal place of business at 1111 Cedar Swamp Road, Old Brookville, New York 11545 ("Banfi").

RECITALS

2. Modelo owns many U.S. Trademark Registrations including Nos.: 1,681,365 for CORONA EXTRA Stylized for use with beer; 1,681,366 for the word mark CORONA Stylized for use with beer; 1,689,218 for CORONA Stylized and Crown and Griffins Design for use with beer; 1,727,969 for CORONA LIGHT Stylized and Crown and Griffins Design for use with beer; 1,729,694 for CORONA EXTRA LAS CERVEZA MAS FINA and Crown and Griffins Design for use with beer; 2,406,232 for CORONA LIGHT Stylized and Crown and Griffins Design for use with beer; 2,452,813 for CORONA MUSIC for providing entertainment information; 2,489,708 for CORONA EXTRA LA CERVEZA MAS FINA Stylized Crown and Griffins Design for use with clothing; 2,489,709 for CORONA Stylized and Crown and Griffins Design for use with clothing; 2,489,710 for CORONA Stylized for use with clothing; 2,489,711 for CORONA EXTRA Stylized for use with clothing; 2,517,268 for CORONA DECOR for use with mail order catalog services; and 2,522,430 for CORONA DECOR Stylized and Design for use with mail order catalog services. The CORONA mark was first used in commerce at least as early as August 1943, and first used anywhere at least as early as 1925.

3. Modelo is also the owner of the following pending U.S. trademark application Serial Nos.: 76/331,791 for GO SOMEPLACE BETTER. GO WHERE THERE'S CORONA AND CORONA LIGHT for beer; 76/231,041 for CORONA EXTRA for promotion of entertainment and sporting events; 76/230,810 for CORONA EXTRA Stylized for promotion of entertainment and sporting events; 76/230,586 for CORONA Stylized for promotion of entertainment and sporting events; 76/230,273 for CORONA for promotion of entertainment and sporting events; 76/229,561 for CORONA TEQUILA for tequila; 76/229,560 for CORONA ZONA for beer; 76/090,433 for CORONA EXTRA for on-line services; 76/090,432 for CORONA Stylized for on-line services; 76/054,459 for CORONA for on-line services; 75/876,359 for CORONA EXTRA Stylized for sporting goods; 75/876,355 for CORONA'S Stylized for restaurant services; 75/875,878 for CORONAMUSIC.COM for providing entertainment information; 75/875,866 for CORONA for restaurant services; 75/875,865 for CORONA EXTRA for sporting goods; 75/875,864 for CORONA Stylized for sporting goods; 75/875,863 for CORONA'S Stylized and Design for restaurant services; 75/875,862 for CORONA Stylized and Design for restaurant services; 75/875,858 for CORONA'S for restaurant services; 75/875,857 for CORONA Stylized for restaurant services; 75/875,621 for CORONA for sporting goods; 75/764,705 for CORONA SPORT Stylized and Crown Design for clothing and sporting goods; 75/689,802 for CORONA for fresh fruit; 75/632,948 for CORONA.NET for on-line services; 75/632,945 for CORONAEXTRA.NET for on-line services; 75/632,870 for CORONA.COM for on-line services; 75/632,869 for CORONAEXTRA.COM for on-line services; and 74/532,463 for PANCHO CORONA for clothing (Modelo's trademark registrations and applications are collectively referred to herein as the "CORONA Marks").

4. Modelo manufactures, sells, distributes, advertises and licenses various types of products, including beer, clothing and sporting goods, and engages in sponsorship and promotional activities related thereto. Modelo utilizes the above-referenced CORONA Marks, including its Crown Designs, in various combinations on its products and services to identify them as originating from Modelo.

5. Banfi is the owner of the trademark "Miscellaneous Crown Design", as shown in Exhibit A attached hereto (the "Banfi Shield Mark"). Banfi has used the Banfi Shield Mark in interstate commerce on wines, grappa, and olive oil since at least as early as 1991.

6. On or about October 9, 2002, Banfi filed a trademark application to register the Banfi Shield Mark for wines in International Class 33. Said application was assigned Serial No. 78/172,568 and was published in the Official Gazette of the United States Patent and Trademark Office on June 17, 2003.

7. Modelo filed a Notice of Opposition against the registration of the Banfi Shield Mark on August 19, 2003. Trademark Opposition Proceeding No. 91157504 ("the Opposition") was instituted on August 26, 2003.

8. The parties wish to avoid the necessity of continuing the Opposition and to resolve this matter.

AGREEMENT

In consideration of the mutual covenants and promises hereinafter made, the parties agree as follows:

1. Banfi will not use or seek to register the Banfi Shield Mark, or any similar mark, for beer or any other alcoholic beverage in International Class 32.

2. Banfi will not use or apply to register the word CORONA as a mark for any goods or services.

3. Banfi will not oppose, object to, institute legal proceedings against, or otherwise challenge Modelo's use, application for registration, or registration of the CORONA Marks as set forth above, or in combination with any other word or design, or any other marks similar thereto, provided that such use is consistent with the terms and conditions of this Agreement.

4. Modelo will not use or seek to register the CORONA Marks, or any similar marks, for wines.

5. Modelo will withdraw the Opposition by executing and filing with the Trademark Trial and Appeal Board ("TTAB") a Notice of Withdrawal in the form attached hereto as Exhibit B. The parties agree that a fully executed copy of this Agreement will be submitted to the TTAB as an attachment to the Notice of Withdrawal. Modelo will file and serve such Notice of Withdrawal within three business days of the execution of this Agreement.

6. Modelo will not to oppose, object to, institute legal proceedings against, or otherwise challenge Banfi's use, registration, or application for registration of the Banfi Shield Mark, or any other marks similar thereto, for use on wine, grappa, or olive oil, provided that such use is consistent with the terms and conditions of this Agreement.

7. Although the parties are unaware of any past or current confusion resulting from the use of their respective marks, and believe that confusion is not likely under the provisions of this Agreement, in the event that either party becomes aware of any actual confusion as to the source or sponsorship of the parties' respective products or services, the parties agree to consult with each other in good faith regarding ways and means to alleviate such confusion.

8. This Agreement will inure to the benefit of, and be binding upon, the parties hereto, their successors, assigns, officers, directors, heirs, agents, subsidiaries, divisions and any related or affiliated parties under their direction or control.

9. Neither the execution of this Agreement nor the compliance with any of its terms is intended to constitute, nor does it constitute, any admission of liability by any party.

10. The failure or omission (intentional or otherwise) of any party to insist upon or enforce any term or condition of this Agreement shall not be deemed a waiver of such term or condition unless the waiver is set forth in writing and signed by the waiving party.

11. Each party will bear its own attorneys' fees and costs in connection with this matter.

12. In the event that it becomes necessary for either party to commence legal action or proceedings to enforce this Agreement after prior written notice to the other party and failure to address the issue within a reasonable time period, the prevailing party shall be entitled to recover its reasonable attorneys' fees and costs thereby incurred.

13. This Agreement will extend to and be effective in the United States of America and its territories and possessions.

14. It is agreed by the parties that all parties have had an opportunity to review this Agreement, that its terms were negotiated by the parties hereto and that no court of law or equity will construe any part or portion of this instrument against any party by virtue of such party's involvement in the drafting of this Agreement or any portion thereof.

15. This Agreement constitutes the entire agreement between the parties and supersedes any other written or oral understandings. This Agreement may be modified only in a writing signed by both parties.

16. This Agreement may be executed in multiple counterparts, each of which shall be an original, and such counterparts together shall constitute one and the same instrument.

IN WITNESS WHEREOF, the parties hereto have caused this Agreement to be executed by their duly authorized representatives, whom, the parties warrant, are expressly authorized to bind the respective parties to all of the terms and conditions hereof.

Dated: ~~November~~, 2003
December 9, 2003

CERVECERIA MODELO, S.A. de C.V

By: 

Name: JORGE SIEGRIST

Title: GENERAL COUNSEL

December 18,
Dated: ~~November~~, 2003

BANFI PRODUCTS CORPORATION

By: 

Name: Philip D. Calderone

Title: Vice President, Gen. Counsel & Secretary

EXHIBIT A

Banfi Shield Mark, subject of United States Trademark Application Serial No. 78/172,568:



EXHIBIT B

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Dated: November __, 2003

By: _____
Michael A. DiNardo, Esq.
Yanny & Smith
1925 Century Park East, Suite 1260
Los Angeles, CA 90067
Telephone: (310) 551-2966

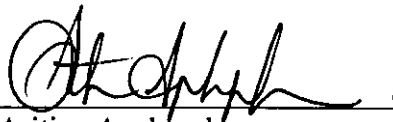
Attorneys for the Opposer
Cerveceria Modelo, S.A. de C. V.

CERTIFICATE OF SERVICE

I hereby certify that on this the 23rd day of December, 2003, I caused to be served a true and correct copy of the Opposer's **NOTICE OF WITHDRAWAL** via U.S. mail for delivery upon the following at the address stated below:

Kristen Walsh
Nixon Peabody LLP
Clinton Square
P.O. Box 31051
Rochester, New York 14603-1051

Attorneys for Applicant
Banfi Products Corporation


Aritina Agalopol